

REMARKS

By the foregoing amendment, claim 48 has been amended and claims 68-94 have been added. Thus, claims 48-94 are currently pending.

In the Office Action mailed May 23, 2000, the Examiner rejected claims 48-65 and 67 under § 103(a) as being unpatentable over U.S. Patent No. 5,586,766 to Forte et al. in view of U.S. Patent No. 5,848,932 to Adams. The Examiner also stated “Alternatively, where the auxiliary game is the well known Ten Stix 21 game, Forte discloses a game and method which shows it is known to automate the tracking and displaying of auxiliary/bonus events for easing the record keeping responsibilities of the dealer. Therefore it would have been obvious to an artisan of gaming to automate the tracking and displaying of the auxiliary events of Ten Stix 21 as taught by Forte in order to ease the record keeping duties of the dealer.”

The Examiner rejected claims 50, 54, and 56-65 under 35 U.S.C. §103(a) as being unpatentable over the patent to Forte et al. in view of U.S. Patent No. 5,707,285 to Place et al. The Examiner rejected claim 66 under 35 U.S.C. §103(a) as being unpatentable over the patent to Forte et al. in view of either the patent to Adams or the patent to Place et al. as applied to claim 60 and further in view of either U.S. Patent No. 5,788,573 to Baerlocher et al. or U.K. Patent No. GB 2,201,821 A of Pickardt et al.

To the extent that these rejections might still be applied to the claims currently pending, they are respectfully traversed as follows.

It is respectfully submitted that claims 48-94 are allowable over the prior art of record at least for the following reasons. It is respectfully submitted that none of Forte et al., Adams, Place et al., the Ten Stix 21 game, Baerlocher et al., nor Pickardt, nor a combination

the controller establishes lesser odds for selecting the greater valued prizes.--

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-87. (Newly added) An apparatus as defined in claim *82*, wherein:

the prize display includes a separate indication for each of the different prizes; and
the controller signals the prize display to light the light emitting element of each
indication of each prize immediately prior to the selection of the prize resulting from the
associated player manipulating the player control element of the player interface unit.--

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-88. (Newly added) An apparatus as defined in claim *87*, wherein:

the controller signals the prize display to light the light emitting element of each prize
indication in a predetermined sequence.--

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-89. (Newly added) An apparatus as defined in claim *88*, wherein:

the indications of each prize are positioned on the prize display in a predetermined pattern
capable of exhibiting a sequence; and
the predetermined sequence of lighting the light emitting elements of each prize
indication is correlated to the predetermined pattern of indications on the prize display.--

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-90. (Newly added) An apparatus as defined in claim *89*, wherein:

the predetermined pattern is a rotational figure; and
the predetermined sequence is a rotational sequence around the rotational figure pattern of
indications.--

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-91. (Newly added) An apparatus as defined in claim *88*, further including:

a speaker connected to the controller; and wherein:
the controller further includes a tone generator connected to the speaker and operative to produce a predetermined audible sound from the speaker during lighting the light emitting elements of each prize indication.--

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--92. (Newly added) An apparatus as defined in claim *27*, further including:

a speaker connected to the controller; and wherein:
the controller further includes a tone generator connected to the speaker and operative to produce a predetermined audible sound from the speaker during lighting of the light emitting elements of the prize indications prior to selection of the prize.--

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--93. (Newly added) An apparatus as defined in claim *92*, wherein:

the controller controls the tone generator to produce an audible sound from the speaker when a bonus point is displayed at each player interface unit.--

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--94. (Newly added) An apparatus as defined in claim 68, wherein:

the dealer interface unit includes a display for displaying game control information to the dealer; and
the controller signals the display of the dealer interface unit to display information prompting the dealer to manipulate the dealer control elements in accordance with rules of play of the auxiliary game.--

of any thereof, disclose or suggest a controller for causing the player interface unit to reset the display element to display the starting number of bonus points in response to the number of bonus points received by the associated player reaching the predetermined number of bonus points, as claimed in claims 48, 50, 52, and 54. Instead, Forte et al. provides for play of the game in which player count values of all players not identified as having been dealt natural or other player jackpot count hands in the current hand are zeroed (col. 4, lines 45-48). None of Adams, Place et al., the Ten Stix 21 game, Baerlocher et al., nor Pickardt disclose or suggest such resetting features, as claimed.

Further, it is respectfully submitted that none of the prior art of record discloses or suggests features providing an incentive to play for players as claimed by the present invention. Forte et al. provides a player counter system for tracking the number of player jackpot tally and dealer counter events occurring during a card game. The disclosed jackpot tally events occurring are such events as consecutive natural or blackjack hands by the players or other winning hands consecutively occurring (see, e.g., col. 3, lines 47-49; col. 4, lines 4-19) or other lower probability player events such as a twenty-one hand count, or relatively low probability dealer events such as consecutive dealer busts or naturals, and are disclosed only for winning events for players. In contrast, for example, claim 48, as amended, as well as claims 50, 52, 54, and 68, provide an incentive for players to play regardless of whether the players are winning or losing the card game by providing a random event that regularly occurs without the need for combinations of events or other low probability events.

It is also respectfully submitted that the present invention is patentable over Forte et al. in view of the Ten Stix 21 game at least for the following reasons. Claims 48, 50, 52, 54, and 68 provide for a controller or use of a controller to control the display of bonus points. This feature

is important not primarily for the reason of “easing the record keeping responsibilities of the dealer” as alleged by the Examiner, but to prevent improper play by the players, a problem identified by the Ten Stix 21 game (see, e.g., specification at p. 4, lines 23-30) and solved by tracking the player counts using electronic displays, rather than the lammers of the prior art, in conjunction with a controller for controlling the display. Neither Forte et al. nor the Ten Stix 21 game, nor any of the other prior art of record disclose or suggest such a protective feature as claimed. To further clarify this feature’s importance, claim 48 has been amended to incorporate specific reference to the advantage of preventing unauthorized transfer of bonus points among players.

At least for the above reasons, it is submitted that claims 48, 50, 52, 54, and 68 are allowable over the prior art of record. It is further submitted that claim 49, which depends from allowable claim 48, claim 51, which depends from allowable claim 50, claim 53, which depends from allowable claim 52, claims 55-67, which depend from allowable claim 54, and claims 69-94, which depend from allowable claim 68 are likewise allowable.

With regard to each of the rejections under § 103 in the Office Action, it is respectfully submitted that the Examiner has not yet set forth a prima facie case of obviousness. The PTO has the burden under § 103 to establish a prima facie case of obviousness. In re Fine, 5 U.S.P.Q.2nd 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under § 103, there must be a showing of proper motivation to do so. The mere fact that a prior art reference could be modified to meet the claim is insufficient to establish obviousness. The PTO “can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary

skill in the art would lead that individual to combine the relevant teachings of the references.” Id. In order to establish obviousness, there must be a suggestion or motivation in the reference to do so. See also In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999).

With regard to the Examiner’s argument that combining of features from Forte et al. with Adams, with Place et al., and with Place et al. in view of Baerlocher et al. or Pickardt et al., as well as the Examiner’s alternative argument that the Ten Stix 21 auxiliary game and the automated counting features of Forte et al. are obvious for the blanket purpose of easing record keeping responsibilities of the dealer, it is respectfully submitted that this argument fails at least because such combinations do not address the problems of providing a card game with the disclosed auxiliary game and preventing improper play by players that occurs with use of such methods as distribution of lammers and other features and play as specifically claimed in claims 48-94. The Examiner indicates no specific teaching or suggestion within the prior art that would support the combination made.

Further, the Examiner’s own admissions and arguments as to combinations of references also support withdrawal of the Examiner’s rejection under section 103(a). In the Response to Arguments, the Examiner states that he “failed [to] ‘catch’ that Adams teaches a dealer interface control unit enabling player actuation of prize win determination device . . .” It is clear from this statement that the Examiner is using hindsight reasoning to combine features from various references in the prior art in order to construct the obviousness rejections made. Such use of hindsight is entirely improper in the context of an obviousness rejection.

The Examiner is requested to cite to specific references, with columns, pages, and line numbers indicated, in the prior art cited supporting the motivation for the combinations the Examiner has indicated.

For all of the above reasons, it is respectfully submitted that the claims now pending patentably distinguish the present invention from the prior art of record. Accordingly, reconsideration and withdrawal of the outstanding prior art rejections and an issuance of a Notice of Allowance are earnestly solicited.

Should the Examiner determine that any further action is necessary to place this application into better form, the Examiner is encouraged to telephone the attorney of record for this matter at the number listed below.

Respectfully submitted,

PIPER MARBURY RUDNICK & WOLFE LLP



Wilburn L. Chesson
Registration No. 41,668
Attorney of Record

1200 Nineteenth Street, N.W.
Washington, D.C. 20036-2412
Telephone No. (202) 861-3900
Facsimile No. (202) 223-2085